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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,427	08/04/2003	Jody L. Leers	CIL1974	4550

7590

08/25/2004

Sean A. Kaufhold  
P.O. Box 131447  
Carlsbad, CA 92013

EXAMINER

CHAPMAN, GINGER T

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/633,427	<b>Applicant(s)</b> LEERS ET AL.	
	<b>Examiner</b> Ginger T Chapman	<b>Art Unit</b> 604	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,790,835 issued to Elias. As best depicted in Figures 1 and 3, Elias discloses a urinary male diaper which includes a tubular shaped sheath constructed of semi flexible moisture resistant material such as rubber (Column 2, lines 37-46). The shield further includes an open proximal end portion and a closed distal end portion; the proximal end portion includes a free flap portion which is discontinuous with respect to the distal end portion and therefore open. The flapped portion defines the tubular member with the first and second ends being open with the distal portion creating a cap integrally coupled to and covering the second end (Column 2, lines 50-60). The free flap portion, on closure, has an edge in normal abutting relationship with the adjacent edge of the distal portion (Claim 1(g)). Elias further discloses the use of an absorbent material, such as absorbent liner of cotton or synthetic hydrophilic material, positioned or secured within the inner surface of the cap end portion of the sheath (Column 3, lines 28-37).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elias as applied to claims above, and further in view of the teachings of U.S. Patent No. 2,577,345 issued to McEwan.

Elias discloses a generally tube shaped urinary diaper, but fails to address the specific use wherein the cap member is generally shaped like the head of a penis. McEwan discloses a mechanical prophylactic adapted to be engaged about an injured extremity having sensitive nerve centers which includes means to cushion the injured extremity from contact with foreign objects (Column 1, lines 11-17).

As best depicted in Figures 2, 4 and 5, McEwan shows an elongated sheath (11) fabricated of a thin rubber-containing material and having one end closed and shaped into an enlarged head (12) (Column 2, line 36). In particular, McEwan teaches a cap (14) shaped into an enlarged head circumposed about the head of the sheath and having its open end (15) secured exteriorly of the sheath at a point adjacent to and spaced from the open end of the sheath; the cap is equally spaced from the walls of the head of the sheath and cooperates with the sheath to form a closed chamber (Column

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1, lines 59-60 to Column 2, lines 1-7). McEwan further provides a cushioning liner (17) interposed between the sheath and the cap (Column 2, lines 8-13) and secured therein (Column 2, line 45). The open end of the McEwan device is rubber-containing (13) and resiliently elastic thereby inherently capable of performing as an elastic band and aiding in ensuring the device does not inadvertently slip off the wearer.

Therefore, it would have been obvious to one of ordinary skill in the art to have provided the male incontinent device of Elias with the shape of McEwan so as to provide comfort in wear and an increased area for attaching the absorbent liner. The resulting article would have provided a cleaner and safer device for protecting the user.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 3,648,700 issued to Warner discloses a contraceptive device including a resilient form-retaining receiver with rounded distal end (2) for receiving a male glans and further including a highly absorbent inner layer (14) and a band (24) to aid in securing the device to the wearer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T Chapman whose telephone number is (703) 305-0471. The examiner can normally be reached on Monday through Friday 8:30 a.m. to 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN J. CALVERT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700